



REMARKS/ARGUMENTS

The Examiner delineated the following inventions as being patentably distinct

Group I, claim(s) 1-4, 8, and 20-21, drawn to methods for determining a polymorphism of the nucleotide sequence of the ABCG2 gene.

Group II, claim(s) 1, 5-8, and 20-21, drawn to methods for determining a polymorphism of the amino acid sequence of the ABCG2 polypeptide.

Group III, claim(s) 9-15, drawn to polynucleotides.

Group IV, claim(s) 16 and 18, drawn to polypeptides and cells producing polypeptides. Group V, claim(s) 17, drawn to antibodies.

Group VI, claim(s) 19, drawn to a method of measuring drug transport.

Group VII, claim(s) 9-18 and 22, drawn to kits comprising nucleic acids, polypeptides, and antibodies.

Group VIII, claim(s) 23, drawn to a computer system.

Applicants provisionally elect with traverse Group I, claims 1-4, 8, 20 and 21. In addition, applicants elect as a single species nucleotide polymorphism at position 421 of SEQ ID NO. 1 also with traverse.

Restriction is only proper if the claims of the restricted groups are either independent or patentably distinct. The burden of proof is on the Office to provide reasons and/or examples to support any conclusions with regard to patentable distinctness. M.P.E.P. § 803.

Applicants respectfully traverse the Restriction Requirement on the grounds that no adequate reasons and/or examples have been provided to support patentable distinctness. Rather the Office has merely stated conclusions. Accordingly, the Office has newly stated conclusions. Accordingly, the Office has failed to meet the burden necessary to sustain the Restriction Requirement, and the Office has not shown that a burden exists in searching all of the claims.

Further, M.P.E.P. § 803 states as follows:

“If the search and examination of an entire application can be made without a serious burden, the Examiner must examine it

on its merits, even though it includes claims to distinct and independent inventions.”

Applicants submit that a search of all claims would not constitute a serious burden on the Office.

In chemical cases, a specified group of materials which do not necessarily belong to an otherwise class can be claimed together employing “Markush” language. The accepted expression for Markush grouping is “...consisting of”. The Markush practice sanctions the claiming together operable situations which could not be defined by generic language but which nevertheless have a community of chemical or physical characteristics. The members of the Markush grouping need only possess at least one property in common which is mainly responsible for the function of the claimed relationship. In the instant application, it is the “determination of a polymorphism of a nucleotide.” The same utility in a generic sense suffices.

The Examiner has failed to consider that the claims in each group are considered related inventions under 37 C.F.R. § 1.475(b) in which the inventions are considered to have unity of invention. Applicants submit that while PCT RULE 13.1 and 13.2 are applicable. 37 C.F.R. 1.475(b) provides in relevant that “a national stage application containing claims to different categories of invention will be considered to have unity of invention”. As the Office has not sufficiently shown any evidence that a restriction should now be required when the International Preliminary Report did not, restriction is believed to be improper.

Applicants respectfully traverse the Election of Species Requirement on the grounds that the Office has not provided sufficient reasons to support conclusions of patentable distinctness.

Applicants make no statement regarding the patentable distinctness of the species but note that for the restriction to be proper there must be patentable differences between the

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Reply to Office Action mailed September 5, 2006

species as claimed. M.P.E.P. §808.01(a). Applicants' election of a species is for examination purpose only.

Finally, with respect to the elected species, Applicants respectfully submit that, should the elected species be found allowable, the Office should expand its search to the non-elected species.

Applicants respectfully submit that the above-identified application is now in condition for examination on the merits and an early notice of such action is earnestly solicited.

Respectfully submitted,

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